

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCE

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Ex parte TURGUY GOKER, JOHN A. HAMMING, RUSSELL A. BAUER  
and KEMPTON W. REDHEAD

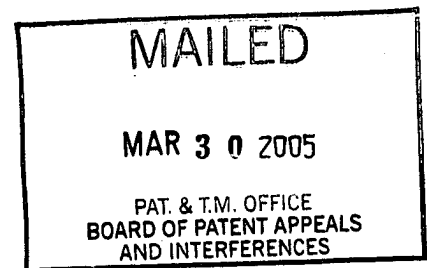
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Appeal No. 2005-0718  
Application 09/911,740

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ON BRIEF

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Before FRANKFORT, McQUADE, and NASE, Administrative Patent  
Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's non-final rejection, in the Office action mailed February 10, 2004, of claims 1 through 9 and 11 through 20, all of the claims remaining in the application. Claim 10 has been canceled.

As noted on page 1 of the specification, appellants' invention relates to a method and apparatus to maintain tension in a tape being unloaded from a tape drive mechanism. More specifically, it is indicated in the paragraph bridging pages 4 and 5 of the specification that

[t]he tape loading mechanism of the present invention, during an unloading operation, uses a motor coupled to a tape cartridge to retract tape that is attached to a hub filler. The retracting tape drags the hub filler and guide arm towards the cartridge. In embodiments of the present invention, the frictional resistance of the hub filler, frictional resistance of the guide arm, the frictional resistance of the guide arm motor, and the magnetic resistance of the guide arm motor maintain adequate tension in the tape. In embodiments of the present invention, additional tension is provided by stimulated electrical induction within the guide arm motor.

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The above-noted tension maintained on the tape during an unloading operation is specifically provided so as to prevent the detachment of the end of the tape (at 404) from the hub filler (402) during a tape unloading operation.

Independent claims 1, 9 and 16 are representative of the subject matter on appeal and a copy of those claims may be found in the Appendix to appellants' brief.

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The prior art references relied upon by the examiner in rejecting the appealed claims are:

Rueger	4,399,936	Aug. 23, 1983
Ohshita	0 467 143 A2	Jan. 22, 1992
(European Patent Application)		

Claims 1 and 2 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ohshita.

Claims 3 through 9 and 11 through 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ohshita in view of Rueger.

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Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding those rejections, we make reference to the examiner's answer (mailed September 9, 2004) for the reasoning in support of the rejections, and to appellants' brief (filed May 6, 2004) and reply brief (filed November 9, 2004) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

With regard to the rejection of claims 1 and 2 under 35 U.S.C. § 102(b), the examiner has pointed us to Figure 3 of Ohshita and urged that the tape threading mechanism seen therein ~~comprises a hub filler (leader block 3) coupled to a guide rail~~ (5b) and means (including a guide arm (17, 18) coupled to hub filler (3) and a guide arm motor (21) coupled to the guide arm) for preventing detachment of an end of the tape (2) from the hub filler (3) during a tape unloading operation. More particularly, it is the examiner's view (answer, page 6) that Ohshita shows the guide arm (17, 18) and motor (21) being dragged, since the tape cartridge (1) winds the tape (2) which is attached to the hub filler (3), and the hub filler is coupled to the guide arm (17, 18). According to the examiner, even if the guide arm motor (21)

rotates in the same direction with the cartridge motor, in order to wind, the cartridge motor must necessarily subject the tape to tension and thereby drag the tape, hub filler, guide arm and motor.

After having carefully reviewed the Ohshita reference, we find no teaching or disclosure therein adequate to support the examiner's determination that during an unthreading/rewinding operation, wherein the leader block (3) is moved from the machine take-up reel (4) back into the cartridge (1), the tape (2) must of necessity be under tension and thereby drag the hub filler/leader block (3), guide arm (17, 18) and guide arm motor (21) so as to inherently produce a force for preventing detachment of the end of the tape from the hub filler/leader block (3) during a tape unloading operation.

In the first place, we note that it is clear from the disclosure of Ohshita that the end of tape (2) is secured to the leader block (3) in an essentially permanent manner so that the leader block is carried by and remains part of the tape and cartridge (1). Note particularly Figures 1(a) through 1(c) of

Ohshita. By contrast, in the application before us on appeal, the hub filler (402) is part of the tape machine itself and the end of the tape (406) is connected to the hub filler by removable engagement of a leader pin (404) in a slot in the hub filler. Note Figures 1-3 of the present application and the disclosure therein on pages 1-4. Thus, the arrangement in Ohshita wherein the tape (2) is secured to the leader block/hub filler (3) would apparently not be subject to the problem addressed by appellants, since it appears that the end of tape (2) will not become disengaged from the leader block/hub filler (3) during an unloading/rewinding operation.

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Moreover, while we would agree with the examiner that the tape (2) of Ohshita is apparently under tension during the initial rewinding of the tape from the machine take-up reel (4) back into the cartridge (1), it appears that when the guide arm motor (21) is energized during the last stage of the unwinding operation so as to drive arms (17, 18) to pull the leader block/hub filler (3) out of the groove (4a) in the take-up reel and move the leader block back to a position for insertion into

the cartridge (Ohshita, col. 4, lines 32-40), the last segment of tape (2) will merely translate as the arm (17, 18) and motor (21) move the leader block (3) in the same direction as the travel direction of the tape and the motor (unshown) driving the tape reel of the cartridge (1) operates to take-up slack in the tape. As a result, it is pure speculation and conjecture on the examiner's part to assert that the tape (2) must of necessity be under tension and thereby drag the hub filler/leader block (3), guide arm (17, 18) and guide arm motor (21) so as to inherently produce a force for preventing detachment of the end of the tape from the hub filler/leader block (3) during a tape unloading operation.

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We also agree with appellants' discussion in the brief (pages 5-9) of the requirement in any evaluation of a "means-plus-function" clause under 35 U.S.C. § 112, sixth paragraph, for such clause to be construed "to cover the corresponding structure, material, or acts described in the specification and any equivalents thereof." In the present case, the examiner clearly has not established that the structure of Ohshita is the same as that described in appellants' application or an equivalent thereof.

Thus, for the above reasons, we will not sustain the examiner's rejection of independent claim 1, or claim 2 which depends therefrom, under 35 U.S.C. § 102(b) as being anticipated by Ohshita.

Concerning the examiner's rejection of claims 3 through 9 and 11 through 20 under 35 U.S.C. § 103(a) based on the combined teachings of Ohshita and Rueger, we find no suggestion or motivation in the applied references which would have led one of ordinary skill in the art at the time of appellants' invention to combine Ohshita and Rueger in the particular manner urged by the examiner. In light of the express disclosure in Ohshita (col. 4, lines 32-40) that the arm (17, 18) and motor (21) are operated to pull the leader block (3) towards a position to be inserted into the cartridge (1) and that during insertion the arm (17, 18) operates to push the leader block against the opposing force of the tongue (1a) provided on cartridge (1), we find no reason that an artisan would attempt to modify the tape feeding mechanism of Ohshita so that the guide arm (17, 18) and motor (21) therein



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would be "dragged by the tape" as is urged by the examiner, even though this is described as one possibility in Rueger's tape threading apparatus (col. 7, lines 12-22).

Moreover, we observe that the mere fact that the prior art could be modified in the manner urged by the examiner would not have made such modification obvious unless the prior art suggested the desirability of the modification. See In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) and In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992). As we noted above, in this case, the applied references to Ohshita and Rueger provide no such teaching or suggestion regarding the desirability of such a modification.

From our perspective, the examiner has relied upon impermissible hindsight and used appellants' claimed invention as an instruction manual or "template" in an attempt to piece together disparate teachings of the prior art so that the claimed invention is rendered obvious. This approach to a determination of obviousness is improper and cannot be sanctioned by this

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Board. See In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed Cir. 1991) and Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

Since the teachings and suggestions found in Ohshita and Rueger would not have made the subject matter as a whole of dependent claims 3 through 8 or independent claims 9 and 16 on appeal obvious to one of ordinary skill in the art at the time of appellants' invention, we must refuse to sustain the examiner's rejection of those claims, and of dependent claims 11 through 15 and 17 through 20 under 35 U.S.C. § 103(a).

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In summary, we have refused to sustain the examiner's rejection of claims 1 and 2 under 35 U.S.C. § 102(b) based on Ohshita and the rejection of claims 3 through 9 and 11 through 20 under 35 U.S.C. § 103(a) based on Ohshita in view of Rueger. Thus, the decision of the examiner to reject the claims of the present application is reversed.

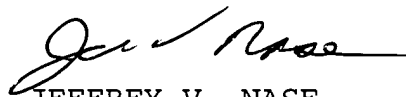
REVERSED



CHARLES E. FRANKFORT )  
Administrative Patent Judge )



JOHN P. McQUADE )  
Administrative Patent Judge )



JEFFREY V. NASE )  
Administrative Patent Judge )

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